



AF/3753
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Serial No.: 10/603,454
In re: Weber Art Unit: 3753
Filed: 06/25/2003 Examiner: Michalsky
For: 3/2 NORMALLY CLOSED MODULE
Docket No.: DP-308,539 Conf. No.: 3279

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

RESPONSE TO OFFICE ACTION

Dear Sir:

In response to the final Office Action mailed September 27, 2004, Applicant hereby respectfully requests reconsideration as further elaborated upon below.

I. INTRODUCTION


Claims 11-16 and 19-23 are presently pending in this application. Applicant hereby respectfully requests reconsideration and withdrawal of the rejection of the claims.

II. CLAIM REJECTION UNDER 35 U.S.C. § 103(a)

Claims 11-13, 16 and 21 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Douglass et al. in view of Avila. Applicant respectfully traverses this rejection.

CERTIFICATE OF MAILING

I hereby certify that this *Response to Office Action* is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450 on this 29 day of November, 2004.


Brenda D. Chambers

The subject matter of U.S. Publication No. US 2004/0045611 A1 is disqualified as prior art, and shall not preclude patentability, pursuant to 35 U.S.C. § 103(c). See also MPEP § 706.02(I)(1). 35 U.S.C. § 103(c) provides:

(c) Subject matter developed by another person, which qualifies as prior art only under one or more of sections (e), (f), and (g) of § 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or is subject to an obligation of assignment to the same person.

At most, U.S. Publication No. US 2004/0045611 A1 would, in the absence of 35 U.S.C. § 103(c), be considered prior art only under 35 U.S.C. § 102(e) (its filing date is earlier than the present application and it has been published in the English language). That is, it is not § 102(b) prior art, nor is it § 102(a) prior art. This aspect of 35 U.S.C. § 103(c) is satisfied.

Moreover, U.S. Publication No. US 2004/0045611 A1 is owned by Delphi Technologies, Inc. and has been at least as early as its filing date. The present application is also owned by Delphi Technologies, Inc. and has been at least as early as its filing date. Thus, both U.S. Publication No. US 2004/0045611 A1 and the present application (Application Serial No. 10/603,454) were, at the time of the invention of the present application were made, both owned by Delphi Technologies, Inc.

Since the conditions of 35 U.S.C. § 103(c) have been satisfied, U.S. Publication No. 2004 0045611 A1 is disqualified as prior art.

Moreover, the Office has not established motivation/incentive to modify Douglass et al. using any secondary reference to include a spring on the inlet ball. The Office has provided two reasons that it asserts provides the proper incentive/motivation: (1) to provide a spring for the inlet ball 64 in the embodiment of Figure 2 of Douglass et al. so as to provide an additional spring bias in addition to the fluid pressure bias on the ball 64 of Douglass et al. so as to return the inlet ball 64 to a close position in the event of failure of inlet pressure; (2) to provide a bias to compensate for the weight of the valve elements in the event that the valve is utilized vertically with the inlet port at the bottom.

First, adding a spring to the configuration of Douglass et al. simply adds cost and complexity to that structure without adding any additional functionality. The inlet fluid pressure is all that is needed to urge the inlet ball into engagement with an inlet seat. In the

event of failure of inlet pressure as set forth in the Office Action, the apparatus of Douglass et al. is configured and would operate to simply apply more current to the solenoid to unseat the ball from the inlet seat ostensibly in an attempt to increase the outlet pressure to compensate for the "failure of inlet pressure." That is, in response to the failure, partial or complete, of inlet pressure, the structure of Douglass is not configured to maintain the inlet ball seated on the inlet seat, which would completely cut off any outlet pressure, but rather is configured to move the inlet ball off of the inlet seat in order to admit more inlet fluid in an attempt to maintain outlet fluid pressure at set levels. Thus, the addition of an inlet spring in the configuration of Douglass et al. actually works against the operation of Douglass et al., not in aid of it. Accordingly, one of ordinary skill in the art would not find an incentive or motivation to include an inlet spring to account for the "failure of inlet pressure." Moreover, Applicant has reviewed the Douglass et al. reference, and finds no disclosure that teaches or suggests that the valve of Douglass et al. will not work in a vertical position, or conversely will only work in a horizontal position. Accordingly, Applicant respectfully submits that without some disclosure to suggest or indicate a problem with vertical operation of the valve in Douglass et al. restricting it to just operation in the horizontal position, one of ordinary skill in the art would not see an incentive or motivation to include a spring "to provide a bias to compensate for the weight of the valve elements in the event that the valve is utilized vertically."

One of ordinary skill in the art would not therefore find an incentive to modify Douglass et al., based on any secondary reference to include an inlet spring, much less based on Avila which is disqualified as prior art.

For at least the foregoing reasons, Applicant respectfully requests reconsideration and withdrawal of the rejection.

III. CLAIM REJECTION UNDER 35 U.S.C. § 103(a)

Claims 14-15, 19-20 and 22-23 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Douglass et al. in view of Avila as applied to claims 11, 16, and 21 above, and further in view of Anderson et al. Claims 14-15, 19-20, and 22-23 respectfully depend on base claims 11, 16, and 21, and accordingly include all of the limitations thereof. Therefore, for at least the same reasons set forth above, Applicant respectfully submits that

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the rejection under 35 U.S.C. § 103(a) as been traversed, and further respectfully requests reconsideration and withdrawal of such rejection.

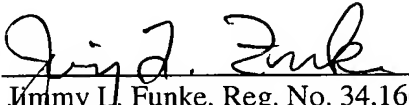
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IV. CONCLUSION

For the foregoing reasons, all presently pending claims are now believed to be in a condition for allowance. Early notice of the same is hereby respectfully requested.

Respectfully submitted,

Date: 29-Nov-2004

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Patent Assignment Abstract of Title

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Total Assignments: 1

Patent #: NONE

Issue Dt:

Application #: 10236242 Filing Dt: 09/06/2002

Publication #: US20040045611 Pub Dt: 03/11/2004

Inventor: Miguel I. Avila

Title: LOW LEAK PRESSURE CONTROL ACTUATOR

Assignment: 1

Reel/Frame: 013279/0149

Recorded: 09/06/2002

Pages: 2

Conveyance: ASSIGNMENT OF ASSIGNORS INTEREST (SEE DOCUMENT FOR DETAILS).

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Exec Dt: 08/23/2002

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